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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/832,823      | 04/12/2001  | Li Li                | 03384.0133-01       | 2661             |

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EXAMINER

HYUN, SOON D

ART UNIT PAPER NUMBER

2661

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/832,823             | LI ET AL.           |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Soon D. Hyun           | 2661                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,8,9,11-16,18,20,21 and 23-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,8,9,13,14,18,20,21,25-27,30-32 and 35-64 is/are rejected.
- 7) ☒ Claim(s) 3,4,11,12,15,16,23,24,28,29,33 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 2, 6, 8, 9, 13, 14, 18, 20-21, 25-27, 30-32, and 35-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (U.S. Patent No. 5,930,257) in view of Applicant Admitted Prior Art (AAPA)

Regarding claims 1, 2, 13, 14, 25, 26, 30, and 31, Smith et al (Smith) discloses a method for routing a call across a first ATM network (an ATM network 407 in FIG. 4 connected to port 201 in FIG. 2, see col. 4, lines 22-42), toward a second ATM network (the second ATM network is connected to one of ports 202-207 in FIG. 2 is not clearly

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shown, but it would have been obvious to one having ordinary skill in the art to connect a second ATM network to a port 202 in FIG. 2, see col. 2, lines 63-65), the call having an associated signaling message (an Ethernet packet generated by Ethernet 410, see col. 5, line 31) specifying a destination address (an destination network address, col. 5, line 19 and used as network-level address as in claim 10) of the second network, the method comprising the steps of:

translating the destination address into a local address (VC1), the VC1 is a address format of the first ATM network and is assigned as a local address by ATM IF of Ethernet 410 (an resolution server as in claim 13) when the destination address is another network, see col. 4, lines 56-64);

repacking the signaling message with the local address as a routing address (the Ethernet packet is segmented into ATM cells with the VC1 address, see col. 5, lines 31-39);

routing the call through the first ATM network using the local address; and  
repacking the signaling message with the destination address as the routing address (ATM interface 425 reassembles the cells with VC1 into the Ethernet packet having the destination address and Routing engine 430 handles the destination address as the routing address to forward the call to the second network, see col. 5, lines 15-23).

However, Smith does not explicitly teach that the second ATM network has a address format different from the address format of the first ATM network.

The AAAP (Specification page 1, lines 5-20), ATM networks having different address formats are used in the private and public networks. Those of skill in the art would have been motivated by the AAAP to connect the second ATM network that has an address format different from the first ATM network such that the two ATM networks having different address formats could communicate each other as long as associated ATM interfaces are provided.

Therefore, it would have been obvious to one having ordinary skill in the art to incorporate the second ATM network into the system of Smith.

Regarding claims 6 and 18, Smith does not explicitly teach the conversion algorithm to obtain the local address, but a process (an algorithm) for the translation of the destination address is inherently required.

Regarding claim 8, 20, 27, and 32, Smith further discloses that the destination address transparently across the first network (col. 5, lines 31-37).

Regarding claims 9 and 21, refer to claims 1 and 13, Smith teaches that a destination address (the destination address is inherently required in the Ethernet protocol and used as a user-level address as in claim 10) in the Ethernet packet header specifies an end system beyond second network, i.e., destination of end system (terminal) of a LAN network connected to the second ATM network.

Regarding claims 35, 45, and 55, refer to the discussion for claim 1. The steps of storing the destination address and associating the call with the stored destination address are inherently required in Smith, because the system uses the method of packet segmentation and reassembling.

Regarding claims 36, 46, and 56, refer to claim 35. The destination address is stored (pushed) into a memory (a stack).

Regarding claims 37, 47, and 57, it is obvious to one having ordinary skill in the art to use LIFO (a last in first out stack) or FIFO (a first in first out stack) based on the order of writing/reading into/from the memory.

Regarding claims 38, 43, 48, 53, 58, and 63, it is inherently required to remove or popping (erase or read-out) the destination address from the memory when the destination address in the memory is not in further use.

Regarding claims 39, 49, and 59, refer to claims 1, 35 and 38.

Regarding claims 40, 50, and 60, refer to claim 8.

Regarding claims 41, 51, and 61, refer to claim 1, a third ATM net work is not clearly shown, but it is obvious to one having ordinary skill in the art to connect the third ATM network that is connected to a port 203 in FIG. 2, (see col. 2, lines 63-65), wherein an additional local address in the address format of the third ATM network is determined.

Regarding claims 42, 52, and 62, Smith further teaches that the port 203 (same structure of port 201 in FIG. 4) is processing the steps of the repacking and routing as recited in claim (col. 5, lines 15-23).

Regarding claims 44, 54, and 64, Smith further teaches that the step of translating occurs at the egress side of the first network (at ATM IF).

***Allowable Subject Matter***

4. Claims 3, 4, 11, 12, 15, 16, 23, 24, 28, 29, 33, and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter.

The prior art of record fails to teach the step of querying the address translation database populated with the address interface identifier pair to obtain the local address as recited in claims 3, 4, 15, and 16.

The prior art of record further fails to teach the step (means) of inserting the local address into the first signaling message parameter as recite in claims 11, 23, and 28.

***Response to Arguments***

6. Applicant's arguments filed 07/20/2005 have been fully considered but they are not persuasive.

Applicant argues that Smith et al is not a proper prior art reference to cite against the claims of the present application, because "at the time the invention claimed in the present application was made, the subject matter disclosed in Smith et al. was subject to obligation of assignment to the predecessor of current assignee Nortel Networks Limited".

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Examiner disagrees. In accordance with the record of Patent Assignment, the Patent of Smith et al was assigned to Nortel Networks Limited on 12/23/1999 and the present application has an effective filing date of December 1, 1997, i.e., at the time the invention claimed in the present application (12/01/1997), the subject matter disclosed in Smith et al was not subject to an obligation of assignment to current assignee Nortel network limited.

Therefore, Smith et al is a proper prior art reference, because the subject matter and the claimed invention were, at the time the claimed invention was made, **not owned by the same person or not subject to an obligation of assignment to the same person.**

For the reasons discussed above, examiner believes that the claim rejection is proper.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of




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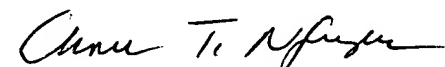
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Soon D. Hyun whose telephone number is 571-272-3121. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
S. Hyun  
09/29/2005



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